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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,186

Applicant(s)

LUNA ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/934730.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-8 are pending in the application.

Claim Objections

2. Claim 4 is objected to because of the following informalities: "said half-cut is has rounded corners" should be "said half-cut has rounded corners." Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 4, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "standard sizes" in claims 2 and 7 is unclear which renders that the claims vague and indefinite. It is unclear what encompasses "standard sizes."

The limitation "said half-cut is has rounded corners" in claims 4 and 8 is unclear which renders the claim vague and indefinite. Claim 1, upon which claim 4 depend, merely recites a continuous, uninterrupted half-cut extending through said photographic paper. Since this limitation reads on a straight line "half-cut" and Applicant has not claimed multiple half-cuts or a

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geometric shape of the of the half-cut it is unclear how it would have corners. It is the same for claim 8, except that claim 8 depends on claim 5.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Viby (WO 99/31644).

Regarding Applicant's claim 1, Viby discloses a digital photographic product (*a label system, title*) comprising a liner (*support sheet, page 6, lines 8-11*), an adhesive adhered to the liner (*page 6, lines 15-17 and figure 1*) and a photographic paper (*printing paper, page 6, lines 8-11*) releasibly carried by the adhesive (*figure 1*).

Regarding the limitation "photographic paper", the Examiner has given the term the broadest reasonable interpretation consistent with the written description in Applicant's specification as it would be interpreted by one of ordinary skill in the art. MPEP 2111. The specification implies that "photographic paper" is paper that is capable of receiving ink/toner such as from an ink-jet printer (*specification page 7, paragraph 25 and claim 1*). Therefore, the Examiner has given the term "photographic paper" the broadest reasonable interpretation in light of the specification, a paper that is capable of receiving ink/toner. Viby's printing paper meets

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this limitation because it is a paper that is printed on such as by an ink jet printer (*page 7, lines 13-15*).

The photographic paper has a continuous, uninterrupted half-cut extending through the photographic paper but not through the liner (*page 6, lined 23-25 and figure 1*), which is deemed to define a photograph area (*labels or tags, page 6, lines 24-25*). The photograph area is smaller than a photographic image to be printed on the photographic paper (*see comment below*) by an inkjet printer and leaving a marginal portion (*paper rim section, page 6, line 25*) outside of the photographic area (*figure 1*).

Regarding the limitation “photograph area smaller than a photographic image to be printed on said photographic paper by an ink jet printed”, the Examiner has given the term the broadest reasonable interpretation consistent with the written description in Applicant’s specification as it would be interpreted by one of ordinary skill in the art. MPEP 2111. The Examiner has interpreted this limitation to mean that the photograph area is smaller than the area of the entire photographic paper, since printers of all types are capable of printing over the entire paper. As seen by figure 1 of Viby the label area is smaller than the area of the printing paper.

The limitation “when said photographic image is printed on said photographic paper using said inkjet printer” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Furthermore, it is noted that Viby does disclose that the label system can be printed on by an inkjet printer (*page 7, lines 13-15*).

The photograph area can be peeled from the marginal portion of the photographic paper and the adhesive to produce a photograph having smooth edges and no adhesive adhered to the photograph (*figure 1 and page 10, line 35 through page 11, line 6 and page 4, lined 29-36*).

Regarding Applicant's claim 2, the digital product is deemed to be dimensioned in standard sizes (*page 4, lines 2-6*) and the photograph area is deemed to be dimensioned in standard sizes (*page 2, lines 18-22 and figure 1*).

Regarding Applicant's claim 4, Viby discloses that the half-cut can have rounded corners (*figure 2*).

Regarding Applicant's claims 5-8, these claims contain method limitations. Method limitations do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Viby discloses the same product structure, see above discussion of claims 1, 2 and 4.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Viby as applied above, and further in view of Schliesman et al. (U.S. Patent No. 6,129,785).

Viby is relied upon as described above.

Viby fails to disclose that the weight of the liner is less than the weight of the photographic paper.

Schliesman discloses that ink jet recording medium can be a paper from light weight Bible paper to heavy specialty papers (*col. 6, lines 12-21*).

Viby and Schliesman are analogous because they both disclose ink jet recording medium.

Therefore, the exact weight of the photographic paper, i.e. ink jet recording medium, and liner is deemed to be a result effective variable with regard to the intended use, such as id cards (*Viby, page 2, lines 18-22*). It would require routine experimentation to determine the optimum value of a result effective variable, such as paper weight, in the absence of a showing of criticality in the claimed paper weight. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by use a heavier weight photographic paper and thus lighter by comparison liner because heavier photographic paper would provide sturdier id cards, i.e. that will not tear as easy.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alicia Chevalier

2/4/05